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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,476	06/24/2003	Edwin G. Duffin	P-9797.00	7245

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MEDTRONIC, INC.
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EXAMINER

KAHELIN, MICHAEL WILLIAM

ART UNIT	PAPER NUMBER
3762	

MAIL DATE	DELIVERY MODE
04/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/601,476

Applicant(s)

DUFFIN ET AL.

Examiner

Michael Kahelin

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9.
Claim(s) withdrawn from consideration: 21-25.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attached "Detailed Action".
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

MRK
4/18/07

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/16/2007 have been fully considered but they are not persuasive. Applicant argued that the combination of Sluetz (US Re. 31,990), Doan (US 7,031,774), and Goldreyer (US 4,365,639) fails to render obvious independent claim 1 because of several alleged divergent features of the various references including: Goldreyer's are not "selectable", but hard-wired; Doan's teaching would result in a boot mounted on the lead body separate from the connector header, as claimed; and combining Goldreyer and Doan would defeat the purpose of Doan's electrode selection feature, namely to affect proper electrode positioning based upon the size of the patient's heart.
2. In response to the argument that the electrodes of Goldreyer are hard-wired and not selectable, Goldreyer was not relied on to teach mechanically slidable or selectable electrodes; both Sluetz and Doan provide this teaching. Goldreyer was relied on for the teaching of providing a lead with a plurality of circumferentially spaced electrodes, and Goldreyer provides these electrodes for the purpose of selecting the most suitable electrode (albeit by solid-state means) for sensing in a very specific area to determine local effects (col. 4, line 59-col. 5, line 12). As such, Examiner maintains that Goldreyer's teaching is a suitable combination because Goldreyer involves the same field of endeavor as Sluetz and Doan, i.e., selecting the ideal electrode configuration, and provides motivation to combine teachings.

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3. In response to applicant's argument that Doan's teaching would result in a boot mounted on the lead body, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As Sluetz discloses a sliding-engagement configuration in a header connector bore, Doan was relied on merely for the teaching of providing a sliding electrode selection means wherein at each position of the lead connector, a first contact and third contact are electrically connected to the pulse generator and a second contact is electrically disconnected from the pulse generator to allow various combinations of electrodes to be in electrical communication with the pulse generator, thusly allowing the location of stimulation to be adjusted after final lead implantation. A combination rejection under 35 USC 103 does not require that *all* features of a secondary reference be incorporated into the primary reference.

4. In regards to the argument that combining Goldreyer and Doan are nonanalogous art because Doan's invention concerns electrode selection for various heart sizes and Goldreyer's electrodes are all at the same longitudinal spacing, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this

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case, both pieces of art are in the same field of endeavor, i.e., intravascular cardiac pacing, and the same problem-solving area, i.e., selecting the ideal electrode configuration for a given implantation configuration.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MWK


4/18/07


GEORGE R. EVANISKO
PRIMARY EXAMINER

4/19/07